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Docket No.: 29827/40663
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Andreas A. Popp et al.

Application No.: 10/516,702 Confirmation No.: 6743

Filed: December 2, 2004 Art Unit: 1712

For: (Meth)Acrylic Esters of Polyalkoxylated Glycerine Examiner: William K. Cheung

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated January 5, 2007, applicants hereby elect the invention represented by the claims of examiner's Group I, namely, claims 1, 4-8, 10-18, 21-23, 26, 27, 29, 30, and 32-34, with traverse, for examination on the merits at this time. Although the Office Action indicates that claims 2, 3, 9, 24 and 25 are in examiner's Group I, it is assumed that this is a typographical error because claims 2, 3, 9, and 24 have been cancelled and claim 25 is in examiner's Group II.

It is submitted, however, that all claims 1, 4-8, 10-18, 21-23, 25-27, and 29-34, i.e., examiner's Groups I and II, should be examined at this time. The novelty of the invention is defined in the claims of both Group I and Group II, which are not two independent and distinct inventions because the statutory requirements of 35 U.S.C. §121, namely, independence and distinctness, are not present herein.

The inventions of examiner's Groups I and II are not independent because the ester compounds and the crosslinked hydrogels set forth in the claims are so closely related

that a search for applicants' elected claims of examiner's Group I would necessarily encompass a search for the crosslinked hydrogel claims of examiner's Group II. Note that a search for elected claims 32-34 would encompass a search directed to nonelected claim 31.

In addition, even if the inventions are considered independent, there is no evidence that a search directed to both the compound claims and the composition/method claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

In particular, it is submitted that a complete search directed to the subject matter of the claims of examiner's Group I would require a search directed to the subject matter of the crosslinked hydrogels claims of examiner's Group II.

Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the compound, composition, and method claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the compound, composition, and method claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action on the merits is solicited.

Dated: February 1, 2007

Respectfully submitted,

By _____

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